

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on January 24, 2003, and the references cited therewith.

Claims 21, 28 and 31 are amended, no claims are canceled or added; as a result, claims 1-2, 4-5, 7-22 and 26-32 remain pending in this application. The amendment to claims 21 and 28 clarify that the communications is a wireless communications. The clarification makes explicit that which was inherent in the claims, since a wireless connection between the hub of the present invention and computer was an element of the base claims for claims 21 and 28. As a result the amendment is not believed to be a narrowing amendment. Claim 31 has been amended to correct a minor typographical error.

§103 Rejection of the Claims

Claims 1-2, 4-5, 7-22 and 26-32 were rejected under 35 USC § 103(a) as being unpatentable over Antos (US Patent No. 5,790,201) in view of Nanba (US Patent 6,297,80). Applicant respectfully traverses the rejection. Further, Applicant does not admit that Nanba is prior art, and reserves the right to swear behind it at a later date. Nevertheless, Applicant respectfully submits that the claims are allowable over Antos in view of Nanba for the reasons argued below.

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that there is no motivation to combine the cited references, and further that the Office Action does not state a proper motivation to combine the

references. As a result, the cited art does not present a *prima facie* case of obviousness with respect to the claims.

The Office Action does not provide a proper motivation to combine the references. The Office Action must show a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. M.P.E.P. 2143.01. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine the reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. In *re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). Mere conclusory statements do not fulfill the Office Action's burden. *Id.* The court in *Lee* also stated that "[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority."

With respect to the motivation to combine Antos with Nanba, Applicant respectfully submits that the Office Action has not provided such required objective evidence or explanation for a suggestion or motivation to combine. Instead, the Office Action merely makes the conclusory statement that the combination of Antos and Nanba "because of its convenience, expandability and support for data exchange between a host computer and a wide range of simultaneously accessible peripherals." Applicant respectfully notes that neither Antos nor Nanba make reference to providing convenient access to a wide range of simultaneously accessible peripherals, therefore they cannot provide objective evidence or explanation of a motivation to combine. For example, Antos is directed to providing a secondary remote keyboard and pointer device for a television and computer integration system (see Abstract). Nanba is directed to a photographing system capable of selecting between a first and second recording medium (see Abstract). Neither reference is directed to providing convenient access to a wide range of simultaneously accessible peripherals. As a result, the Office Action fails to provide any proper objective evidence or explanation of a suggestion or motivation to combine Antos and Nanba. Applicant respectfully requests the withdrawal of the rejection of claims 1-2, 4-5, 7-22 and 26-32.

Additionally, a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be

said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

As discussed in the response submitted November 14, 2002, Antos teaches away from the proposed combination. Antos expressly states that its keyboard “preferably includes an **integral mouse 30 and an integral joystick 32** electrically coupled thereto as shown (see Antos at column 3, lines 27-29, emphasis added). Figure 1 of Antos shows the peripherals directly connected to the keyboard 14, and does not teach any use of connectors according to the present invention. Thus, the use of integral connections in Antos teaches away from the use of removable connectors for connecting peripherals. As a result, the combination of Antos and Nanba is improper because Antos teaches away from their combination.

Furthermore, Applicant respectfully submits that the Office Action inappropriately relies on Nanba, since it involves nonanalogous art to Applicant’s endeavor. In order to determine if a reference is analogous art, the prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned. *In re Oetiker* 24 USPQ2d 1443 (Fed. Cir. 1992). *Oetiker* further states:

We have reminded ourselves and the PTO that it is necessary to consider ‘the reality of the circumstances,’ . . . in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. . . . There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. The knowledge cannot come from the applicant’s invention itself. *In re Oetiker*, 24 USPQ2d at 1446

As noted above, Nanba is directed to the field of photography, providing a photographing apparatus that uses a discriminator to select between first and second recording media (see column 1, line 65 to column 2, line 46). When applying the reasonable and common sense approach of *In re Oetiker*, it would not be reasonable to expect one skilled in the art to look in

the field of photography apparatus when designing a peripheral communications hub. As a result, Nanba is not analogous art and cannot be properly combined with Antos.

For all of the above reasons, there is no motivation to combine Antos with Nanba. Applicant respectfully requests the withdrawal of the rejection of claims 1-2, 4-5, 7-22 and 26-32.

With respect to claims 21-22 and 28, the Office Action admits that neither Antos nor Nanba teach sending a single signal to the main computer. However, the Office Action appears to take official notice stating, "the concept and advantages of multiplexing signals from a plurality of devices onto a single signal for wireless transmission is old and well known in the art." Applicant respectfully traverses this official notice and requests the Examiner to provide a reference that describes such functionality, and further such functionality with respect to USB data. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Additionally, Antos teaches away from sending a single signal. FIG. 1 of Antos and the accompanying descriptive text at column 3, lines 39-54 clearly shows separate signals 35, 36 and 38 being sent for each of the mouse, keyboard and joystick.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

BRUCE A. YOUNG ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date July 24, 2003

By R 2-2
Rodney L. Lacy
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 24 day of July, 2003.

Rodney L. Lacy
Name

R 2-2
Signature